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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Norman M. Mazer
v.
Electronic Realty Associates, L.P.

Cancellation Nos. 23,341 and 24,964

Paul R. Melletz for Norman M. Mazer

Joseph B. Bowman of Kokjer Kircher Bowman & Johnson for Electronic Realty Associates, L.P.

Before Seeherman, Hanak and Quinn, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Norman M. Mazer (petitioner) seeks to cancel two registrations owned by Electronic Realty Associates, L.P. (respondent). Both registrations are for the mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT!. The services of both registrations are identical, namely, "real estate brokerage services." The first registration (Reg. No. 1,562,854) - which is the subject of Can. No. 23,341 – is on the Supplemental Register. The application which matured into

this registration was filed on January 14, 1988. The registration issued on October 24, 1989. The second registration (Reg. No. 1,899,160) – which is the subject of Can. No. 24,964 – is on the Principal Register. The application which matured into this registration was filed on January 16, 1990. The registration issued on June 13, 1995.

Can. No. 23,341 was initiated on October 21, 1994. Can. No. 24,964 was initiated on December 1, 1995. As explained in this Board's order of July 2, 1996, on May 17, 1996 respondent filed a motion to consolidate the two cancellation proceedings. Petitioner filed no objection to the consolidation request. Because the two proceedings involved common questions of law and fact, respondent's motion was granted.

Both petitions set forth the identical two grounds for cancellation. First, petitioner alleged that for at least thirteen years before respondent's alleged date of first use (February 1983), petitioner had used the phrase IF WE DON'T SELL IT, WE'LL BUY IT in connection with his real estate related services. Petitioner further alleged that said phrase "has attained substantial value, which is identified with petitioner." Finally, petitioner alleged that his phrase IF WE DON'T SELL IT, WE'LL BUY IT and respondent's mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! are so

similar such that their contemporaneous use is likely to cause confusion, mistake or deception.

Second, petitioner alleged that respondent's mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! is merely descriptive.

Respondent's answers denied the pertinent allegations of the petitions for cancellation. In particular, respondent denied that its mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! is merely descriptive. (Answers paragraph 9). In its answers, respondent set forth the affirmative defenses of acquiescence, laches, estoppel, estoppel by laches, estoppel acquiescence and unclean hands. (Answers paragraph 11). However, in its answers, respondent never in any manner set forth the claim that petitioner's phrase IF WE DON'T SELL IT, WE'LL BUY IT was descriptive of any real estate related services.

Both parties filed briefs. Neither party requested a hearing.

As set forth at pages 1-4 of respondent's brief, the record in this case consists of the deposition testimony of petitioner Norman M. Mazer taken on July 17, 1995 (with exhibits) and the file histories of Reg. Nos. 1,562,854 and 1,899,160. To be perfectly clear, respondent made of record no evidence. While at page 4 of its brief respondent states that its record consists of the aforementioned registration files, in point of fact, pursuant to Trademark Rule 2.122(b)

these registration files form "part of the record of the proceeding without any action by the parties."

We will consider first petitioner's claim that respondent's mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! is merely descriptive of real estate brokerage services. (Petitions paragraph 9). With regard to respondent's Reg. No. 1,562,854 on the Supplemental Register, this allegation is not a legally sufficient ground to challenge this registration. It is perfectly permissible to register on the Supplemental Register a descriptive term or phrase. Even if petitioner had established that IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! was descriptive of real estate brokerage services, respondent would still be entitled to its registration of this phrase on the Supplemental Register.

As for petitioner's challenge to respondent's registration of this phrase on the Principal Register, a review of the file of Reg. No. 1,899,160 reveals that respondent obtained this registration by establishing pursuant to Section 2(f) of the Lanham Trademark Act that said phrase had become distinctive of respondent's real estate brokerage services. Indeed, in an opinion dated September 29, 1994 this Board explicitly stated at page 4 that respondent (then applicant) had proven the "distinctiveness" of its mark IF WE DON'T SELL YOUR HOUSE,

WE'LL BUY IT! This decision was in connection with application Serial No. 74/019,291 which matured into Reg. No. 1,899,160.

Accordingly, the party plaintiff (petitioner) "has the initial burden to establish prima facie that the applicant [respondent] did not satisfy the acquired distinctiveness requirement of Section 2(f)." Yamaha International v. Hoshino Gakki, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). See also Omnicom Inc. v. Open Systems, 19 USPQ2d 1876, 1878 (TTAB 1989). While Mr. Mazer did testify that in his view respondent's mark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! is descriptive (Mazer dep. 44-45), the fact remains that petitioner (Mr. Mazer) simply did not carry his initial burden of establishing that respondent did not satisfy the acquired distinctiveness requirement of Section 2(f). Moreover, while Mr. Mazer did testify that in the early 1970's there were two or three other real estate concerns that were using the same phrase which he commenced using in 1970, namely, IF WE DON'T SELL IT, WE'LL BUY IT, it must be remembered that respondent did not claim that it commenced using its slightly different mark (IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT!) until 1983. All of the acquired distinctiveness evidence which respondent (then applicant) submitted in application Ser. No. 74/019,291 (which matured into Reg. No. 1,899,160) was in the time

frame from 1983 to 1992. Thus, even if there were three or four real estate firms (including petitioner) using the phrase IF WE DON'T SELL IT, WE'LL BUY IT in the early 1970's, this would not constitute prima facie evidence that respondent (as then applicant) did not satisfy the acquired distinctiveness requirement of Section 2(f) by showing that between 1983 and 1992 the somewhat different phrase IF WE DONT SELL YOUR HOUSE, WE'LL BUY IT! had acquired distinctiveness as indicating real estate brokerage services originating from respondent.

In sum, with regard to both of respondent's registrations, petitioner's claim that respondent's mark is merely descriptive is resolved in favor of respondent and against petitioner.

We will now consider petitioner's claim pursuant to Section 2(d) of the Lanham Trademark Act, namely, priority of use and likelihood of confusion. Petitioner has established through his own testimony, supplemented by exhibits, that he continuously used since 1970 the phrase IF WE DON'T SELL IT, WE'LL BUY IT in connection with his real estate brokerage services. In this regard, petitioner has submitted photocopies of newspaper advertisements for his real estate brokerage services dating back to 1970 wherein the phrase IF WE DON'T SELL IT, WE'LL BUY IT appears in prominent lettering. Indeed, this lettering is just as

large as is the lettering utilized to depict petitioner's name (Norman M. Mazer). Moreover, in its brief, respondent has conceded "that petitioner's first use of his slogan [IF WE DON'T SELL IT, WE'LL BUY IT] established by competent evidence in this case … is at least as early as 1987." (Respondent's brief page 7). Because respondent has made of record no evidence in this proceeding, respondent's earliest "proven" first use dates are the filing dates for the two applications which matured into the two registrations. As previously noted, the filing date of the application which matured into the Supplemental Registration is January 14, 1988. The filing date for the application which matured into the Principal Registration is January 16, 1990. See Acme-McCrary Corp. v. Oxford, 151 USPQ 721, 722 (TTAB 1966); Philip Morris Inc. v. He-Man Products, 157 USPQ 200, 201 (TTAB 1968). Thus, respondent by its own failure to offer evidence and by its admission that petitioner used his slogan at least as early 1987 has conceded the issue of priority of use to petitioner.

To be perfectly clear, at page 13 of its brief respondent makes the following statements: "Second, on priority of use, petitioner's first use of his slogan [IF WE DON'T SELL IT, WE'LL BUY IT] established by competent evidence in this case … is at least as early as 1987. [However,] this Board has previously found, in the file

history of Registration No. 1,899,160, that registrant [respondent] has used its slogan [IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT!] at least as early as 1983." However, the fact that the Board found in an ex parte proceeding that respondent used its slogan at least as early as 1983 is of no consequence in this inter partes proceeding. See 4 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 32:95 at page 32-116 (4th ed. 1998). Moreover, in any event, the record establishes that petitioner made continuous use of his slogan IF WE DON'T SELL IT, WE'LL BUY IT since 1970, some 13 years before respondent's claimed first use date of 1983 for respondent's slogan IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! Thus, priority of use rest in favor of petitioner.

Finally, we find that the slogans of the two parties (IF WE DON'T SELL IT, WE'LL BUY IT versus IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT!) are so similar that when they are used on identical services (real estate brokerage services) there is a likelihood of confusion. While not dispositive of the issue, we note that in a letter dated October 5, 1994 to petitioner, respondent's general counsel stated that petitioner's use of another very similar slogan (IF I DON'T SELL IT, I'LL BUY IT) constituted an infringement of petitioner's registered trademark IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! (Mazer exhibit 31).

Thus, we find that petitioner has established the two elements of his Section 2(d) claim, namely, priority of use and likelihood of confusion. As previously noted, petitioner has established that he has made prominent, continuous use of his slogan IF WE DON'T SELL IT, WE'LL BUY IT since 1970. Moreover, as also noted, respondent has never raised the defense that petitioner's slogan is itself descriptive of real estate brokerage services. Indeed, quite to the contrary, respondent has stated in its answers that the very similar slogan IF WE DON'T SELL YOUR HOUSE, WE'LL BUY IT! is not descriptive of real estate brokerage services. (Answers paragraph 9). See also respondent's brief page 11. Thus, the possible issue of the descriptiveness of petitioner's own slogan IF WE DON'T SELL IT, WE'LL BUY IT has never been pled, and certainly never tried. Moreover, while petitioner did testify that in the early 1970's there were two or three other real estate firms that used slogans identical to or very similar to his slogan, the fact remains that for about 20 years, there has been no evidence of the use by other real estate concerns of petitioner's slogan. Accordingly, under the facts of this case, and in particular the absence of any challenge by respondent to petitioner's slogan, we find it inappropriate to decide whether petitioner's slogan IF WE DON'T SELL IT, WE'LL BUT IT was at one time descriptive, and if so, whether

said slogan has now acquired a secondary meaning as the result of petitioner's continuous use of it for over 25 years.

Decision: The petitions for cancellation are sustained solely on the ground of priority of use and likelihood of confusion (Section 2(d) of the Lanham Trademark Act).

E. J. Seeherman

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal